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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,555	01/08/2002	Frank G. D'Andrea JR.	1303.01	1323
7590	05/11/2004		EXAMINER	
Melvin K. Silverman 500 WEST CYPRESS CREEK ROAD SUITE 500 Fort Lauderdale, FL 33308			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/039,555	D'ANDREA ET AL.	
	Examiner Ismael Negron	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 January 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 13-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 08 January 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on January 14, 2004 has been entered. Claims 13, 18 and 19 have been amended. Claims 1-3, 6-8 and 12 have been cancelled. Claims 21-26 have been added. Claims 13-26 are still pending in this application, with claims 13, 19 and 22 being independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over TSENG (U.S. Pat. 5,615,945).

TSENG discloses a computer illumination device having:

- **a base bracket**, Figure 2, reference number 3;
- **the bracket being able to be inserted into an expansion slot of a computer**, column 2, lines 61-63;
- **the bracket having a housing**, Figure 2, reference number 31
- **means for supplying power**, Figure 2, reference number 32;

- **the means for supplying power being located in the housing,** column 2, lines 28-30;
- **a flexible lamp neck,** Figure 2, reference number 1;
- **the flexible lamp neck extending from the bracket,** column 2, lines 24-28;
- **the flexible lamp neck also in electrical communication with the means for supplying power,** column 2, lines 30-33;
- **a lamp,** Figure 2, reference number 2;
- **the lamp being located on the flexible neck at an end opposite the bracket,** column 2, lines 24-28;
- **the lamp being in electrical communication with the means for supplying power,** column 2, lines 30-33;
- **a switch,** Figure 2, reference number 23;
- **the switch being in electrical communication with the means for supplying power,** columns 2 and 3, lines 65-67 and 1-3, respectively; and
- **the lamp including a heat shield,** Figure 2, reference numbers 26 and 27.

TSENG discloses all the limitations of the claimed invention, except the illumination device being coupled with an expansion slot cover (ESC), the power source being self-contained and independent from the power supply of the computer, or such power supply being rechargeable batteries.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the device of TSENG in coupled with a computer ESC to illuminated the interior of a computer (or any other area), as evidenced by TSENG in column 3, lines 4-21.

The examiner takes Official Notice that the use of self-contained power sources, such as rechargeable batteries is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a rechargeable battery as the power source in the illumination device of TSENG. One would have been motivated since rechargeable batteries are recognized in the illumination art to have many desirable advantages, including dependability, long cyclic life and lower operating cost over regular batteries. In addition, the use of a rechargeable battery would enable the illumination device to operate even when the computer is turned off or unplugged.

Response to Arguments

3. Applicant's arguments filed January 14, 2004 have been fully considered but they are not persuasive.

4. Regarding the Examiner's rejection of claims 13-20 (claimed subject matter now presented in claims 13-26) under 35 U.S.C. 103(a) as unpatentable over TSENG (U.S> Pat. 5,615,945), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically a power source independent of the

computer's power supply (rechargeable batteries), the switch means being accessible from outside of the computer, and the claimed device being located inside the computer case (as summarized in page 9, first paragraph of applicant's response).

5. In response to applicant's argument regarding the power source being rechargeable batteries the applicant is respectfully directed to Section 2 of the instant Office Action (or Section 3 of the previous) where such feature is addressed with an obviousness statement.
6. In response to applicant's argument the device disclosed by TSENG is not located inside the computer case, it is noted that such feature is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In this case the claims define a computer illumination device *for illuminating the interior of a computer* (emphasis added), nowhere in the claims is the device recited as being located inside the computer.

The illumination device of TSENG is specifically designed to provide an illumination function when coupled to a computer expansion port. Connecting such device to a back expansion port instead of a side expansion port of a laptop computer (as disclosed by TSENG in Figure 4) and rearranging the flexible lamp neck 1 to direct light from the lamp to the interior of the computer relates to the use that a given user

would give to the patented structure, and as such is not a patentable feature even if such use was considered to be novel. See MPEP § 2112.

7. Regarding the switch means being accessible from outside of the computer, as the applicant will now agree, the switch 23 disclosed by TSENG is accessible from outside the computer since the complete lamp assembly is located outside the computer.

8. In response to applicant's comments that the device of TSENG is physically incapable of being used for the intended purpose of the claimed invention, the applicant is advised that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The illumination device of TSENG is specifically designed to provide an illumination function when coupled to a computer expansion port. Connecting such device to a back expansion port instead of a side expansion port of a laptop computer (as disclosed by TSENG in Figure 4) fails to define a patentable invention. See MPEP § 2112.

TSENG discloses the patented invention as being used in combination with a laptop computer (Figure 4), however, the invention is not limited to such computers. In addition, while laptop computers include expansion ports positioned at the sides, almost every computer, laptop or desktop, feature expansion ports located in back panels.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER
PRIMARY EXAMINER


Inr

May 5, 2004